

REMARKS

As presently amended the application contains three claims namely claims 1, 4, and 5. Claim 1, and 4 are independent. Claim 5 is dependent on claim 1.

Support

Support for the amount of filler namely 0.1 to 1 parts by weight can be found in the specification as filed on page 15 at about line 14.

Claim 1 has been amended by incorporating therein most of the subject matter of both claims 2 and 3, which have themselves been cancelled. Support for the subject matter of claims 1, 2, and 3 is not in dispute.

Issues under 35 USC 112

The rejection of selected claims in paragraph 5 of the last Office Action under the second paragraph of 35 USC 112 is traversed but is believed to have been overcome by the present amendments. Claims 1 and 3 have been cancelled rendering their rejection moot.

The term "controlled" objected to by the Examiner in paragraph 5a has been rendered moot by the removal of this term from all claims.

The resin forming components are now clearly defined in the claims.

The use of transitional phrases, such as "comprising", is believed to be in accordance with common practice.

Claim 2 has been cancelled rendering moot its rejection in paragraph 6 on page 6 of the last Office Action.

The Prior Art

In support of the rejection the examiner relies on twenty (20) references as listed on two pages of form PTO-892 attached to the last Office action. The Examiner has graciously identified each reference with a single letter. Thus on page 1, column 2 of form PTO-892 the Examiner refers to US patents identified as references A through J inclusive and "Non-Patent Documents" identified as references U, V, W, and X. On page 2 of form PTO-892 the Examiner refers to references U, V, and W; references that the undersigned will refer to as references UU, VV and WW to avoid confusion with references listed on page 1.

Before responding to the specific rejections made by the Examiner, it is useful to keep in mind certain specific features of the invention defined by the pending claims which is not shown in the references.

Neither reference A, nor B, nor C, nor D, nor E, nor F, nor G, nor h, nor I, nor J, nor N, nor O, nor P discloses or suggests the photopolymerizable unsaturated compound as defined by paragraph (A) beginning in claim 1 and about line 9.

Reference J relates to a solder resist. Assuming for the sake of argument that reference J discloses the photopolymerizable unsaturated compound as defined by paragraph (A), reference J still fails to disclose or suggest the present invention for a number of reasons.

Reference J discloses silica, whereas the present invention employs an aerogel namely "silica sol" (claim 4, line 7).

Reference J discloses silica for the purpose of thickening, a purpose wholly different than that of the present invention.

The amount of filler in the claimed invention is "0.1 to 1 parts by weight" (claim 1 line 4) which is totally different than the 2 to 35% disclosed by reference J.

Issues under 35 USC 102

The rejection of claim 1 and 5 in paragraph 2 on page 6 as lacking novelty over the references there cited is traversed, but has been rendered moot by the present amendment. Other differences between the claimed invention and the teachings of the references follow.

Reference E does not disclose the resin of the claims. References C, G, and F employ fillers for a different use in a different technical field. Reference U gives no explanation regarding silica sol. Reference D adds a filler to a printed circuit board material as described in column 10, but the purpose of the addition is different. Furthermore, this difference in purpose and a lack of description of the kind and quantity do not allow one to infer the effects of the present invention.

The rejection of claims 1 and 5 in paragraph 3 on page 9 as lacking novelty over the references there cited is traversed, but has been rendered moot by the present amendment. Other differences between the claimed invention and the teachings of the references follow.

In references A and B, the amount of the filler added and the kind of the filler are different than that claimed.

The rejection of claims 1, 3 and 5 in paragraph 4 on page 9 as lacking novelty over reference O is traversed, but has been rendered moot by the present amendment. Other differences between the claimed invention and the teachings of reference O follow.

Reference O relates to adhesives for use in FPC and may or may not belong to the same technical field as that of the present invention. In any case, the purpose of addition and the amount of the filler are different than that of the claimed invention.

The rejection of claims 1 and 5 in paragraph 5 on page 11 as lacking novelty over reference I is traversed, but has been rendered moot by the present amendment. Reference I does not disclose an amount of filler within the scope of that claimed.

The rejection of claims 1, 2 and 5 in paragraph 6 on page 12 as lacking novelty over reference J is traversed, but has been rendered moot by the present amendment. Reference J does not disclose an amount of filler within the scope of that claimed. Furthermore, the filler is added for the purpose of thickening, a purpose wholly different than that of the present invention.

The rejection of claims 1 and 5 in paragraph 7 on page 12 as lacking novelty over reference P is traversed, but has been rendered moot by the present amendment. Reference P does not disclose an amount of filler within the scope of that claimed. Furthermore, the filler is added for the purpose of thickening, a purpose wholly different than that of the present invention.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact David R. Murphy (Reg. No. 22,751) at the telephone number of the undersigned below, to conduct an interview

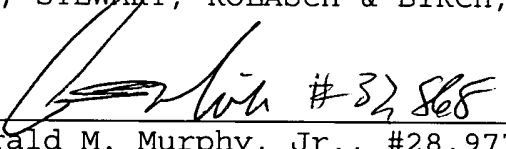
Appl. No. 09/933,946

in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #32,868
for Gerald M. Murphy, Jr., #28,977

GMM/DRM/enm
1752-0145P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000